

REMARKS

This Amendment is submitted in response to the Office Action dated December 28, 2000. In the Office Action, the Patent Office objected to the drawings as failing to comply with 37 CFR §1.84(p)(5) because they do not include the reference "23" as mentioned in the description. The Patent Office objected to the drawings as failing to comply with 37 CFR §1.84(p)(4) because reference characters "23" and "13" have both been used to designate a "return receipt postcard" and because reference character "218" has been used to designate both "perforated tear lines" and an "auxiliary label". Further, the Patent Office rejected Claims 1-3, 7-9, and 11 under 35 U.S.C. 103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725). Still further, the Patent Office rejected Claims 4 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Petkovsek* (U.S. Patent No. 5,697,648). Finally, the Patent Office objected to Claims 5, 6 and 10 as being dependent upon a rejected base claim, but stated the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant notes with appreciation the allowance of Claims 13-20.

By the present amendment, Applicant added new Claims 21-23 and amended Figure 10, the specification, and Claims 1 and 9. Applicant submits that the newly added claims and amendments to the drawings, specifications, claims and the following remarks overcome

the objections and rejections as made by the Patent office and places the application in condition for allowance.

More specifically, Figure 10 was amended to include the new reference character "217" referencing a perforated tear line as shown in red ink on the attached drawing. The specification was amended to correct a typographical error by replacing the reference character "23" with "13". The specification was further amended by replacing "218" with "217" after the words "perforated tear lines 216," in paragraph twenty-six of the DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS. Applicant submits that the drawings and specification as amended overcome the objections of the Patent Office for failing to comply with 37 CFR §1.84(p)(5) and with 37 CFR §1.84(p)(4). Notice to that effect is requested.

With respect to the objections of Claims 5, 6 and 10, for being dependent upon a rejected base claim, Applicant added new independent Claims 21-23 incorporating dependent Claim 5 to Claim 1, dependent Claim 6 to Claim 1, and dependent Claim 10 to Claim 9. Applicant submits that newly added Claims 21-23 are allowable. Notice to that effect is requested.

With respect to the rejection under 35 U.S.C. §103(a) of Claims 1 and 9 as being unpatentable over *Walz*, Applicant respectfully submits that amended Claims 1 and 9 distinctly define the present invention from *Walz* or any art of the record, taken singly or in combination.

More specifically, Claim 1 was amended to define a special service mailing assembly having a label. The label has a front side and a backside and includes a return postcard integrally formed with a designator section indicative of a special service. The designator section is completely contained within the exterior sides that define the return postcard. The label includes shading and printing of a single color.

Further, Claim 9 was amended to define a method for preparing a mailpiece for delivery by a special service. The method has the steps of providing a label and providing at least one anchor portion. The label has a front side and a back side. The label includes a return postcard integrally formed with a designator section indicative of a special service. The designator is contained completely within exterior sides that define the return postcard. The label also includes shading and printing wherein the shading and printing are a single color. The anchor portion is on an exterior side of the return postcard and the anchor portion has a backside wherein the backside of the anchor portion has an adhesive. The method also has the steps of removing a backing strip disposed over the adhesive and attaching the label to a mailpiece to effect delivery by the special service.

Petkovsek teaches a mailing assembly including a single sheet that provides a label that may be attached to an envelope and a return postcard which may be removably attached to an envelope.

Walz merely defines a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. One of the separable sections includes a return postcard.

Nowhere do *Petkovsek* or *Walz* teach a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is completely contained within the exterior sides that define the return postcard. The arrangement of the return postcard with the designator section provides at least two forms on a single sheet. This arrangement allows incorporation of what previously required completion of at least two forms and subsequent attachment of two forms to, for example, a package requiring delivery by a special service. As a result, the mailing assembly of the present invention simplifies and expedites the preparation of a mailpiece requiring delivery by a special service.

In addition, this method allows the user to forgo using a second assembly for a second designated special service for an item to be mailed requiring delivery by a special service.

The Patent Office submits "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed." (Office

Action dated December 28, 2001, paragraph 4.) Further, the Patent Office submits that "when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability." (Office Action dated December 28, 2001, paragraph 4.)

Contrary to this assertion by the Patent Office, the designator section is integrally formed with the return postcard wherein the designator section is completely within the exterior sides that define a return postcard. This arrangement of the return postcard with the designator section provides at least two forms on a single sheet. This arrangement allows incorporation of what previously required completion of at least two forms and subsequent attachment of two forms to, for example, a package requiring delivery by a special service. Thus, the functional relationship is altered.

The Patent Office provided no teaching as to why one having ordinary skill in the art would modify the form that was applied in the Office Action in the rejection under 35 U.S.C. §103(a) and to modify that form to use the same with information related to the delivery of the article by a special service.

It is further submitted that the question under 35 U.S.C. §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

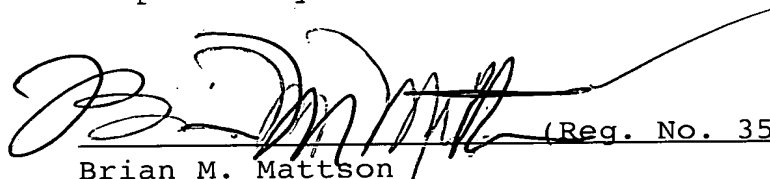
With the analysis of the deficiencies of the *Walz* patent in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Walz* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Claims 2-8 depend from Claim 1; and Claims 10-12 depend from Claim 9. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural

elements and novel steps of Applicant's novel assembly and method for preparing mailpieces, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.


Respectfully submitted,

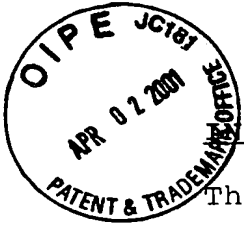

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CERTIFICATE OF MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231 on March 28, 2001.


Brian M. Mattson



THE SPECIFICATION:

The fourth paragraph of the "DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS" should be modified as follows:

The assembly 10 also has a front bottom portion 18 that includes the return receipt postcard [23] 13 that can be similar to United States Postal Service form PS-3811. The return receipt postcard 13 may include a set of instructions 20 for the sender, as well as an article addressee section 22 for pre-printing the addressee's address. The return receipt postcard 13 also has a document control number bar code 24 to aid in tracking of the article 14.

The twenty-sixth paragraph of the "DETAILED DESCRIPTION OF THE PRESENTLY PREFERRED EMBODIMENTS" should be modified as follows:

Referring now to Figures 10-12, an alternate embodiment of a mailing assembly 200 is generally illustrated. The assembly 200 incorporates a first layer 202 and a second layer 204 with an adhesive 206 in selected areas therebetween as generally illustrated in Figures 11 and 12. The first layer 202 of the mailing assembly 200 includes a return postcard 208 with an incorporated designator section 210. At each end of the return postcard 208 are anchor portions 212,214 separable by perforated tear lines 216,[218] 217, respectively. On a back side of each of the anchor portions 212,214 is the adhesive 206. The adhesive 206 provides for attachment of the first layer 202 to the second layer 204 and following removal of the first layer 202 from the second

layer 204, the adhesive 206 beneath the anchor portions 212,214 allows for attachment of the first layer 202 to a mailpiece. An auxiliary label 218 is provided exterior to the anchor portion 212 and has the adhesive 206 on its back side. As a result, the auxiliary label 218 may be implemented as described with references to Figures 7-9.

IN THE CLAIMS:

Claim 1, as amended, follows:

1. (Amended) A special service mailing assembly comprising:
a label having a front side and a backside wherein the label includes a return postcard [and] integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color.

Claim 9, as amended, follows:

9. (Amended) A method for preparing a mailpiece for delivery by a special service, the method comprising the steps of:

providing a label having a front side and a back side wherein the label includes a return postcard [and] integrally formed with a designator section indicative of a special service wherein the designator is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color;

providing at least one anchor portion on an exterior side of the return postcard wherein the anchor portion has a backside and further wherein the backside of the anchor portion includes an adhesive;

removing a backing strip disposed over the adhesive; and

attaching the label to a mailpiece to effect delivery by a special service.